

FAX RECEIVED

OCT 31 2002

GROUP 1600

Attorney Docket No.: 10028.204-US

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: M. Rasmussen

Confirmation No: 8949

Serial No.: 09/869,855

Group Art Unit: 1636

Filed: July 5, 2001

Examiner: T. McKelvey

For: Method For Increasing Gene Copy Number In A Host Cell And Resulting Host Cell

## CERTIFICATE OF FACSIMILE TRANSMISSION

Commissioner for Patents  
Washington, DC 20231

Sir:

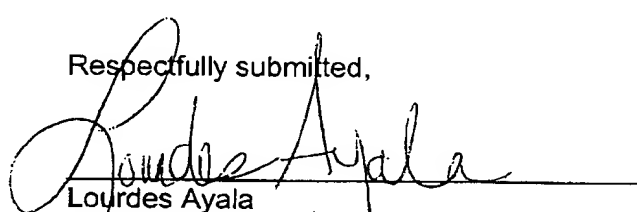
I hereby certify that the attached correspondence comprising:

1. Response to Restriction Requirement

was sent to the United States Patent Office by telefax to the attention of Examiner T. McKelvey,  
fax number (703) 308-4242

Respectfully submitted,

Date: October 30, 2002

  
Lourdes Ayala  
Novozymes North America, Inc.  
500 Fifth Avenue, Suite 1600  
New York, NY 10110  
(212) 840-0097

Attorney Docket No.: 10028.204-US

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: M. Rasmussen

Confirmation No: 8949

Serial No.: 09/869,855

Group Art Unit: 1636

Filed: July 5, 2001

Examiner: T. McKelvey

#8

For: Method For Increasing Gene Copy Number In A Host Cell And Resulting Host Cell

**RESPONSE TO RESTRICTION REQUIREMENT**Commissioner for Patents  
Washington, DC 20231

Sir:

This paper is filed in response to the Office Action mailed October 2, 2002 that made a election of species requirement between the following groups:

1. Methods or products drawn to different chromosomal genes that encode an enzyme, and
2. Methods or products drawn to the precursor and corresponding inhibitory compounds.

The election of species requirement is respectfully traversed.

The above-captioned application was entered into the national stage under 35 U.S.C. 371, i.e. filed via the PCT. For these types of applications, the PTO follows the rules set forth in 37 C.F.R. 1.401 - 1.499.

The standard for determining whether unity of invention exists during the national stage, i.e. whether a restriction requirement may be imposed, is set forth in 37 C.F.R. 1.475(a) which provides:

An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.... Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Moreover, under 37 C.F.R. 1.475(b), an international or a national stage application in the national stage complies with the unity of invention requirement if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specially designed for carrying out the said process.

In the present case, the inventions relate to methods for producing host cells and therefore form a single general inventive concept. Significantly, no objection to unity of invention was raised at any point during the PCT prosecution. Indeed, the International Searching Authority conducted a search of the entire claimed subject matter.

Moreover, Applicants submit that election of species requirements are not permitted under the Patent Cooperation Treaty.

For the foregoing reasons, Applicants submit that the election of species requirement is improper. Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

In order to be fully responsive, Applicants hereby elect the following species: galactose epimerase as the enzyme, UDP-galactose as the inhibitory compound, and galactose as the precursor. Applicants hereby reserve the right to file continuing applications directed to the nonelected subject matter.

The Office Action also acknowledged Applicants' claim of priority, however, stated that none of the certified copies have been received. This is respectfully traversed.

As stated above, the instant application is a national phase application filed under 35 USC 371. Applicants filed a certified copy of the priority application with the International Bureau. Applicants submit that they are not required to file a certified copy with the USPTO.

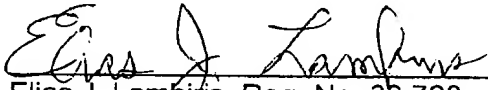
Under Rule 17.2 of the PCT which is recited in section 1828 of the MPEP, "[t]he International Bureau shall, at the specific request of the designated Office ... furnish a copy of

the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy...." Applicants respectfully request that the Office acknowledge receipt of the priority document in the next communication.

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this response or application.

Respectfully submitted,

Date: October 30, 2002

  
Elias J. Lambiris, Reg. No. 33,728  
Novozymes North America, Inc.  
500 Fifth Avenue, Suite 1600  
New York, NY 10110  
(212) 840-0097